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In re Application of	:	
WADLEY	:	DECISION
Application No.: 10/522,068	:	
PCT No.: PCT/US2003/023043	:	
Int. Filing Date: 23 July 2003	:	
Priority Date: 25 July 2002	:	
Attorney's Docket No.: 3053.138.US	:	
For: METHOD FOR MANUFACTURE OF CELLULAR :	:	
MATERIALS AND STRUCTURES FOR BLAST AND :	:	
IMPACT MITIGATION AND RESULTING :	:	
STRUCTURE	:	

This is a decision from the Office of PCT Legal Administration in response to applicant's "REQUEST FOR RECONSIDERATION/REVIEW OF DECISION ON PETITION FROM RESTRICTION REQUIREMENT UNDER 37 CFR § 1.144" filed in the United States Patent and Trademark Office (USPTO) on 26 September 2008.

BACKGROUND

On 23 July 2003, applicant filed international application PCT/US2003/023043, which designated the United States and claimed a priority date of 25 July 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 05 February 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 25 January 2005.

On 21 January 2005, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration of the inventor.

On 28 July 2005, the USPTO mailed a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) according a 371(c)(1), (c)(2), and (c)(4) date of 21 January 2005.

On 10 January 2007, an Office action was mailed setting forth a lack of unity requirement between Groups I and II.

On 09 May 2007, applicant filed a "Response to Restriction and Election Requirement Under 35 U.S.C. § 1.121" electing Group I with traverse. Applicants urged that the common technical feature provided a contribution over the prior art.

On 08 August 2007, an Office action was mailed addressing applicant's traversal and making the lack of unity requirement final.

On 10 December 2007, applicant filed a response again traversing the lack of unity requirement.

On 25 March 2008, an Office action was mailed again addressing applicant's traversal and making the lack of unity requirement final.

On 26 June 2008, applicant filed a "PETITION FROM RESTRICTION REQUIREMENT UNDER 37 CFR § 1.144".

On 22 September 2008, a decision was mailed indicating that the restriction requirement between Groups I and II was maintained and that the petition was denied.

On 26 September 2008, applicant filed the instant "REQUEST FOR RECONSIDERATION/REVIEW OF DECISION ON PETITION FROM RESTRICTION REQUIREMENT UNDER 37 CFR § 1.144".

On 15 October 2008, a Final Office action was mailed.

DISCUSSION

Unity of invention (not restriction) practice is applicable in national stage applications submitted under 35 U.S.C. 371. MPEP § 1893.03(d). During the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rules 13.1 and 13.2 will be followed when considering unity of invention claims. MPEP § 1850, item I.

PCT Rule 13.1 states

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

PCT Rule 13.2 states

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

As noted in the decision mailed 26 September 2008 and the Office action mailed 10 January 2007, the examiner set forth the Lack of Unity requirement as follows:

Group I, claims 1-35, drawn to a structure.

Group II, claims 36-39, drawn to a method of constructing a structure.

The groups were indicated as lacking unity of invention because the common technical feature failed to provide a contribution over the prior art.

Applicant urges that 37 CFR 1.475(b) precludes the restriction requirement. 37 CFR 1.475(b) states in relevant part:

An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- 1) A product and a process specially adapted for the manufacture of said product; . . .

Although 37 CFR 1.475(b)(1) indicates that a national stage application containing claims to different categories of invention will be considered to have unity if the claims are drawn to a product and a process specially adapted for the manufacture of said product, this illustration is only an "interpretation[] of and not an exception to the requirements of PCT Rule 13.1". MPEP § 1850, item III, second full paragraph. Examples are set out in Chapter 10 of the International Search and Preliminary Examination Guidelines. Paragraph 10.21 of the Guidelines clearly illustrates that if the common technical feature among the product and process is known in the art, unity is lacking.

10.21 Example 1

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The (method of) use of substance X as an insecticide.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is substance X. However, **if substance X is known in the art, unity would be lacking because there would not be a special technical feature common to all the claims.** (emphasis added)

CONCLUSION

For the reasons set forth above, applicants' petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

The period for reply set forth in the Final Office action mailed 15 October 2008 continues to run.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

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